REMARKS/ARGUMENTS

These remarks are submitted responsive to the office action dated September 21, 2005 (Office Action). As this response is timely filed within the three-month statutory period, neither an extension of time nor a fee is required.

In the Office Action, Claims 1, 7-9, 15, and 21-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by "Segue Software Announces Resource Monitoring of E-Business Applications with SilkMonitor", Business/Technology Editors, Business Wire, published October 24, 1999, (hereinafter "Segue"). Claims 1-22 were rejected under 35 U.S.C. § 102(a) as being anticipated by "LoadRunner: The Industry Standard Load Testing Tool" by Mercury Interactive Inc. (hereinafter "Mercury"). Claims 1, 2, 9 and 15 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,360,332 to Weinberg, *et al.* (hereinafter Weinberg).

In response to the Examiner's remarks set forth at page 4 of the Office Action, Claims 1, 2, 9, 11, 13-15, and 16 have each been amended by substituting the phrase "simulated transaction work request" for "placebo transaction work request." Applicants thank the Examiner for suggesting this claim language.

Applicants also have amended independent Claims 1, 9, and 15 to further emphasize certain aspects of Applicants' invention. The claim amendments, as discussed herein, are fully supported throughout the Specification. (See, e.g., Specification, p. 4, lines 5-6; p. 7, lines 2-5; and p. 9, lines 6-7.)

I. Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing each of the references cited in the Office Action. One embodiment of the invention, typified by independent Claim 1, as amended, is a method for simulating application workloads on an e-business application server. The method can include forwarding a simulated transaction work request to the e-business application server. The

transaction work request can be configured, according to the method, such that the application server need not be suspended from processing applications during processing of the simulated transaction request. Instead, the application server can continue hosting a plurality of application programs. (See, e.g., Specification, p. 4, lines 5-6 and p. 7, lines 2-5.) The simulated transaction work request can be further configured to include a priority indicator. According to the method, the simulated transaction work request can result in a load being applied to the e-business application server that hosts the plurality of application programs

Further, according to the method, the forwarded simulated transaction work request can be received by a workload driver, which can automatically translate the simulated transaction work request into a computer program operation that can be performed in the e-business application server based on the priority indicator. (See, e.g., Specification, p. 9, lines 6-7.) The automatically translating step can be determined by reference to configuration information contained within a configuration file, the configuration file associating computer program commands with transaction work requests. The method can conclude by executing the computer program operation in the e-business application server so as to stimulate the application of a load on the server.

II. The Claims, As Amended, Define Over The Prior Art

As already noted, the claims were deemed to have been anticipated by each of the cited references, Weinberg, Segue, and Mercury. Applicants respectfully maintain that each of the references fails to teach, expressly or inherently, every feature recited in independent Claims 1, 9, and 15, as amended.

Weinberg is directed to a "software-implement testing tool" that automatically records a series of user steps taken during a user session with a transactional server. (See, e.g., Col. 2., lines 13-17, and Abstract.) In particular, the testing tool of Weinberg

records "interactions between a user and the transaction server as the user performs a transaction, such as a business process." (Col. 2, lines 23-26.)

Weinberg is fundamentally different from Applicants' invention in that with Weinberg it is a user, interacting through a "user interface of the testing tool," who directs the steps that are recorded during a testing phase. (Col. 8, lines 48-51.) With Weinberg, a test is "run" or "executed" under the control of a testing program that executes on the server. (Col. 5, lines 11-14.) During the testing, the testing program presents to the user a "hierarchical node structure" in a graphical user interface, but it is the user, interacting with the server, who is "controlling execution of the test." (Col. 5, lines 52-65; see also Col. 11, lines 13-36; Col. 19, line 48 - Col. 20, line, 15.)

By contrast, Applicants' invention utilizes a simulated transaction work request, forwarded to a server and automatically translated by a workload driver, that simulates a load on a server. It is the translation of the simulated transaction work request, not user interactions, that results in the computer program operations performed to simulate a load on the server, as recited in each of independent Claims 1, 9, and 15, as amended.

Weinberg also fails to expressly or inherently teach that the computer program operations performed to simulate the load are translated from configuration information contained within a configuration file, as recited in each of the independent claims. Weinberg, in particular, does not teach, expressly or inherently, a configuration file that can be reconfigured to vary the processing complexity and duration of one or more computer program commands.

Moreover, Weinberg does not expressly or inherently teach simulating a load on a server by executing computer program commands based on the priority indicator, as further recited in amended independent Claims 1, 9, and 15. Weinberg discloses the use of parameters generally. But the term "parameter" applies broadly. In the context of computing devices, the widely-adopted definition is a user-adjustable quantity that governs some aspect of a device's performance. (See, e.g., <www.digitalhymnal.org/

glossary m-z.html>.) Without more, the mere mention of parameters suggests nothing about prioritizing computer commands. Where Weinberg does explicitly discuss parameters, it has nothing to do with a priority of computer commands: "[t]he testing tool preferably uses two types of parameters – input parameters and output parameters." (Col. 15, lines 47-60.) These types of parameters have nothing to do with a priority of computer commands, as recited in each of the independent claims, as amended.

Segue is equally silent regarding these features. Segue is a Web page that describes software for resource monitoring of e-business applications. With regard to load and performance testing, Segue merely discloses that its software "can measure the performance of servers subjected to millions of simulated transactions a day" and that it "will help evaluate the scalability of e-business applications by identifying memory leaks, for example."

The reference thus is little more than what the software purportedly can do, but it describes nothing about how it accomplishes the tasks. Specifically, Segue nowhere teaches, expressly or inherently, a simulated transaction work request having a priority indicator. Segue likewise does not expressly or inherently teach automatically translating the simulated transaction work request into computer operations to be performed based on the priority indicator. Segue is also entirely silent, for example, about a configuration file that can be reconfigured so as to vary the computer program commands' processing complexity and duration. All of these features, recited in each of the amended independent claims, are absent form Segue.

Segue, moreover, does not provide for testing a server as the server is hosting other applications. This is made explicit in the reference where it is stated that the software is intended to test performance of an e-business system "prior to deployment" of the system. Thus, Segue fails to teach expressly or inherently another feature explicitly recited in each of the amended independent claims.

With respect to the third reference, Mercury, Applicants respectfully disagree that this reference teaches every feature found in amended independent Claims 1, 9, and 15. More importantly, however, Applicants respectfully note that the only indication of the date of the reference is the 2001 copyright notice. Applicants further respectfully assert that they conceived of their invention and actively pursued its reduction to practice from a time prior to the Copyrighted 2001 effective date of Mercury and that, therefore, Mercury can not be applied against Applicants' invention.

In support of their assertion, Applicants submit the attached Declarations of the inventors. The Declarations, along with evidence of activity on specific dates also submitted herewith, establish conception and continuing diligence from a time prior to the effective date of Mercury.

The Declarations are accompanied by a copy of Confidential Invention Disclosure No. BOC8-2000-0096, titled "Simulation of Application Workloads" (Disclosure). The Disclosure was submitted by Applicants on November 14, 2000, to an IP professional employed by the assignee of the invention, International Business Machines Corporation (IBM). The disclosure was revised by Applicants on November 17, 2000. The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 17, 2000, which predates the effective date of Mercury.

The Disclosure is an IBM confidential disclosure form. It is a standardized document utilized, according to established IBM procedures, by IBM inventors upon their conception of an invention. The procedures established by IBM govern the internal use of the confidential disclosure forms. One aspect of IBM's procedures governing the use of the confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after its submission to an IBM Attorney/Patent Professional. Any such changes and/or additions are appended as an attachment to an IBM confidential disclosure form together with the date the attachment was added.

The present application, including each claim, was prepared based upon Applicants' Disclosure attached hereto. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the application prior to its submission to the U.S. Patent and Trademark Office to ensure that the claims and material contained therein were fully supported by the Disclosure.

Moreover, Applicants exercised due diligence from prior to the effective date of Mercury through to the date the present application was filed. With respect to Applicants' diligence it is to be noted that, as set forth in the Declarations, once an IBM disclosure form is completed, the disclosure is reviewed by an internal Invention Review Board (the Board) within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon the Board's reaching a decision to prepare an application, outside counsel is selected to prepare the application. Instructions for preparing the application together with the IBM invention disclosure form are then conveyed to the outside counsel. Outside counsel prepares a draft of the application. The application is subsequently reviewed by each inventor. The inventors, according to this standard procedure, must be satisfied that the application sufficiently details the inventive concepts described in the Disclosure.

Consistent with these established procedures, during the period between November 17, 2000, and July 31, 2001, an outside search firm conducted an initial patent search, the Board assigned the application to outside counsel, and outside counsel drafted the present application. The draft application prepared by outside counsel was reviewed by the inventors, with whose input the application was finalized in its submitted form. This activity of reviewing a patent application is consistent with the exemplary activities often noted as satisfying the legal requirements for a showing of diligence. *See, e.g.*, MPEP 715.07(a). Evidence of these activities is presented in Composite Exhibit "A," attached hereto:

1. Correspondence from IBM to outside counsel on November 29, 2000, instructing outside counsel to prepare and file Application;

2. Facsimile correspondence from outside counsel to Inventor Hand on May 3, 2001, forwarding a copy of the disclosure for additional review and information;

3. Facsimile correspondence from outside counsel to Inventor Flores on June 21, 2001, forwarding a copy of the draft application for review;

4. Correspondence sent via overnight delivery to Inventor Flores forwarding a copy of the final draft application and the formal papers for signing;

5. Facsimile correspondence dated July 30, 2001 from Inventor Hand forwarding the signed formal documents for filing with the Application.

Consistent with professionally-accepted practices, outside counsel prepares cases on a "first come, first served" basis, though applications associated with bar dates are granted priority within the work queue. As proof that the present application was included within the work queue and receiving due attention, Applicants submit herewith outside counsel's handwritten docket sheets dated February 28, 2001, April 29, 2001, May 29, 2001 and June 29, 2001. This evidence is attached hereto as Composite Exhibit "B."

Applicants respectfully submit that the evidence convincingly establishes reasonable diligence from a time prior to the effective date of Mercury to the filing date of the present Application. Accordingly, Applicants respectfully maintain that when coupled with the evidence of conception, the evidence of Applicants' diligence effectively removes Mercury from consideration against Applicants invention.

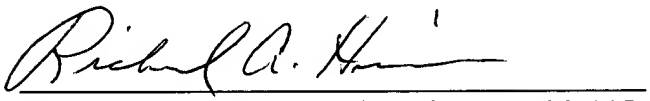
CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: December 21, 2005



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